82. (new) The medium of claim 77, wherein the performance feedback is received via e-mail.

83. (new) The medium of claim 77, wherein the performance feedback is received via a proxy server.

84. (new) A method for online advertisement selection, comprising:

(a) means for receiving feedback on performance of each of a plurality of online advertisements with respect to an advertiser Web site;

(b) means for receiving a request to display an online advertisement to a user; and

(c) means for selecting, in response to the request and the performance feedback, one of the plurality of online advertisements for display based on a predictive model.

REMARKS

The Examiner has objected to the drawings, rejected all previously pending claims in various permutations under 35 U.S.C. § 102 and § 103, and provisionally rejected certain previously pending claims under the judicially created doctrine of obviousness-type double patenting.

Applicants have replaced all previously pending claims with new claims in order to better represent the invention to the Examiner. Thus, Applicants respectfully request reconsideration of the application with respect to claims 63-84 in light of the following remarks.

Objection To Drawings Deferred

The Drawings are objected to by the Draftperson under 37 C.F.R. § 1.84. As permitted by the Examiner in the Office Action, Applicants request that the Objection to Drawings be held in abeyance until allowable subject matter is indicated.

The Claims Are Not Anticipated by Kohda

The Examiner rejected former claims 1-2, 7-8, 50-51, 60 and 61-62 under 35 U.S.C. 102(b) as being anticipated by Kohda (May 1996 article entitled "Ubiquitous advertising on the WWW: Merging advertisement on the browser"). Applicants respectfully traverse this rejection, and submit that each pending claim is patentably distinguishable over Kohda.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Such anticipation does not occur in the instant application, however, because Kohda fails to disclose a system or method for selecting an online advertisement based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site.

Each independent claim in the present invention (claims 63, 70, 77 and 84) requires that the selection of an advertisement be based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site. See specification, paragraph spanning pages 16-17. Kohda neither teaches nor discloses selection of an ad based upon its performance feedback.

Kohda merely discloses an advertising agent that provides an advertisement to a user's Web browser, which is enhanced to merge the advertisement with someone else's Web page. The advertisement is selected based upon interests provided by the user when the user registers with the agent (Kohda, pages 1494-1495, Sections 2.1-2.2). Nothing in Kohda teaches or discloses selection of an ad based upon its performance feedback.

Accordingly, as claims 64-69 depend from and further limit independent claim 63, claims 71-76 depend from and further limit independent claim 70, and claims 78-83 depend from and further limit independent claim 77, Applicants respectfully submit that all of the pending claims, independent and dependent, are not anticipated by Kohda under 35 U.S.C. § 102.

The Claims Are Not Anticipated by Wexler

The Examiner rejected former claims 1, 7, 19, 25, 32, 38 and 44 under 35 U.S.C. 102(e) as being anticipated by Wexler (U.S. Patent No. 5,960,409). Applicants respectfully traverse this rejection, and submit that each pending claim is patentably distinguishable over Wexler.

As stated above, in order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Anticipation does not occur in the instant application, however, because Wexler fails to disclose a system or method for selecting an online advertisement based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site.

Again, each independent claim in the present invention (claims 63, 70, 77 and 84) requires that the selection of an advertisement be based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site. See specification, paragraph spanning pages 16-17. Wexler neither teaches nor discloses selection of an ad based upon its performance feedback.

Wexler simply discloses a third party accounting and statistical service that accumulates statistical information relating to a user clicking through a banner ad. This information includes number of received request signals, which can be reported to the advertiser or banner publisher to indicate effectiveness of the advertising. (Wexler, column 4, lines 54-67). Wexler's third party accounting and statistical service, which the Examiner seemingly equates with the advertisement server of the present invention, does not even select ads, much less select ads based upon their performance feedback.

Accordingly, as claims 64-69 depend from and further limit independent claim 63, claims 71-76 depend from and further limit independent claim 70, and claims 78-83 depend from and further limit independent claim 77, Applicants respectfully submit that all of the pending claims, independent and dependent, are not anticipated by Wexler under 35 U.S.C. § 102.

The Claims Are Not Anticipated by Angles

The Examiner rejected former claims 1-2, 7-8, 19-20, 25-26, 32-33, 38-39, 44-45 and 60 under 35 U.S.C. 102(e) as being anticipated by Angles (U.S. Patent No. 5,933,811). Applicants respectfully traverse this rejection, and submit that each pending claim is patentably distinguishable over Angles.

As stated above, in order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Anticipation does not occur in the instant application, however, because Angles fails to disclose a system or method for selecting an online advertisement based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site.

Again, each independent claim in the present invention (claims 63, 70, 77 and 84) requires that the selection of an advertisement be based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site. See specification, paragraph spanning pages 16-17. Angles neither teaches nor discloses selection of an ad based upon its performance feedback.

Angles discloses an advertisement provider computer that selects ads based upon a consumer profile provided by a consumer when the consumer registers with the advertisement provider computer. (Angles, column 14, lines 16-26 and column 15, lines 20-31). Nothing in Angles teaches or discloses selection of an ad based upon its performance feedback.

Accordingly, as claims 64-69 depend from and further limit independent claim 63, claims 71-76 depend from and further limit independent claim 70, and claims 78-83 depend from and further limit independent claim 77, Applicants respectfully submit that all of the pending claims, independent and dependent, are not anticipated by Angles under 35 U.S.C. § 102.

The Claims Are Not Anticipated by Minor

The Examiner rejected former claims 1-2, 7-8, 19-20, 25-26, 32-33, 38-39 and 44-45 under 35 U.S.C. 102(e) as being anticipated by Minor (U.S. Patent No. 5,740,252). Applicants respectfully traverse this rejection, and submit that each pending claim is patentably distinguishable over Minor.

As stated above, in order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Anticipation does not occur in the instant application, however, because Minor fails to disclose a system or method for selecting an online advertisement based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site.

Again, each independent claim in the present invention (claims 63, 70, 77 and 84) requires that the selection of an advertisement be based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site. See specification, paragraph spanning pages 16-17. Minor neither teaches nor discloses selection of an ad based upon its performance feedback.

Minor discloses an entry web site that embeds demographic information of a user in a redirect to a user-requested web site. The demographic information is provided by the user when the user registers with the entry web site. The user-requested Web site, or remote web site as referenced in Minor, may customize its web page for the user according to the demographic information provided in the redirect from the entry web site. (Minor, column 3, line 45 to column 4, line 53). There is no teaching or disclosure that Minor's remote web site, which the Examiner seemingly equates with the advertisement server of the present invention, even selects

or serves ads, much less selects ads based upon their performance feedback.

Accordingly, as claims 64-69 depend from and further limit independent claim 63, claims 71-76 depend from and further limit independent claim 70, and claims 78-83 depend from and further limit independent claim 77, Applicants respectfully submit that all of the pending claims, independent and dependent, are not anticipated by Minor under 35 U.S.C. § 102.

The Claims Are Non-Obvious Over Kohda, Wexler, Angles and Minor

The Examiner rejected former claims 3-6, 9-49 and 52-59 under 35 U.S.C. 103(a) as being unpatentable over Kohda, Wexler, Angles, and Minor, either in combination with other references or in combination with knowledge of one of ordinary skill in the art.

With respect to an obviousness rejection under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143.

Applicants respectfully submit that the Examiner does not establish a *prima facie* case of obviousness, because the suggestions or motivations provided by the Examiner do not cure the deficiencies of Kohda, Wexler, Angles, and Minor (the 35 U.S.C. § 102 art) as explained above.

Accordingly, Applicants submit that all of the pending claims, independent and dependent, are non-obvious over Kohda, Wexler, Angles, and Minor under 35 U.S.C. § 103.

Double-Patenting Rejection Over U.S. Patent No. 5,948,061 Deferred

The Examiner rejected former claims 1-3, 7-9, 19, 25-27, 32-34, 38-40 and 44-46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-10, 20, 32-39 and 45-47 of U.S. Patent No. 5,948,061.

Since U.S. Patent No. 5,948,061 is currently in reissue (Reissue Patent Application No. 09/577,798), Applicants believe this rejection to be a provisional double patenting rejection. As such, Applicants respectfully request that this rejection be held in abeyance until one of the applications are allowed or the rejection becomes moot via further prosecution of the applications.

Double-Patenting Rejection Over Copending Patent Application No. 09/362,008 Deferred

The Examiner provisionally rejected former claims 1, 3-4, 7, 9-11, 19, 21-22, 25, 27-28, 32, 34-35 and 50 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 19-20, and 41-44 of copending Application No. 09/362,008.

Applicants respectfully request that this rejection be held in abeyance until one of the applications are allowed or the rejection becomes moot via further prosecution of the applications.

CONCLUSION

It is respectfully submitted that the foregoing remarks demonstrate that the application is in condition for allowance and prompt notification thereof is requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current response to Office Action. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**."

The Office is authorized to charge the three-month extension of time fee of $890.00 to Deposit Account No. 11-0600. Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned to discuss any matter regarding this application.

Respectfully submitted,

KENYON & KENYON

Dated: May 14, 2001

By: 

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

All previously pending claims (claims 1-62) have been canceled.

New claims 63-84 have been added.